

REMARKS

In this paper, claim 12 is currently amended. After entry of the above amendment, claims 12-21 are pending, and claims 1-11 and 22-34 have been canceled.

An Information Disclosure Statement (IDS) accompanies this amendment. If the IDS is not in the PTO file when the examiner considers this amendment, the examiner is encouraged to contact the undersigned so that a duplicate copy may be provided.

Claims 12-14 and 18 were rejected under 35 U.S.C. §102(b) as being anticipated by Nagano (EP 0 512 149 A1). The applicant respectfully requests reconsideration of this basis for rejection.

The issue in this case is what effect the word “dimensioned” has in the phrase “wherein the threaded outer peripheral surface is dimensioned to fit within the inner peripheral surface of the axle.” The applicant relied upon the *Orthokinetics* case to support the argument that the word “dimensioned” is a positive structural limitation that distinguishes the claimed axle bolt from the screw ring (3) in Nagano. The office action states that *Orthokinetics* does not apply and that the more appropriate case is *Watts v. XL Systems Inc.*, 56 USPQ.2d 1836, 1840 (Fed.Cir. 2000). The applicant does not dispute the applicability of *Watts* to the present case, because the word *dimensioned* in that case *also* was interpreted to be a positive structural limitation. More specifically, the phrase in that case was “tapered external threads dimensioned such that one such joint may be sealingly connected directly with another such joint.” The court held that the claim language “dimensioned such that” limited the invention to structures utilizing misaligned taper angles.

It is well settled that a claim preamble has the import that the claim as a whole suggests for it. Bell Communications Research, Inc v. Vitalink Communications Corp. 34 USPQ.2d 1816, 1820 (Fed.Cir. 1995). That is especially the case where, as here, the preamble is essential to understand limitations or terms in the claim body. Pitney Bowes, Inc. v. Hewlett-Packard Co. 51 USPQ.2d 1161, 1165 (Fed.Cir. 2002). In this case, the statements in the preamble are not mere statements of intended use. Instead, they are statements that specifically limit the claimed bolt to a bolt that is dimensioned to fasten a crank arm *to the axle that rotates during pedaling*. The preamble makes

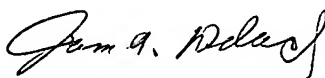
clear that such an axle is *not* to be interpreted to be a bottom bracket shell (5) disclosed by Nagano, which is part of the bicycle frame and does not rotate as the bicycle is pedaled. More specifically, the claims are limited to the relatively small bolt used to fasten a crank arm to the axle that rotates during pedaling, not to the relatively large bolt used to secure the entire pedal assembly to the bicycle frame (which does not rotate during pedaling).

Claims 15-17 and 19-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nagano. This basis for rejection is respectfully traversed for the same reasons noted above.

Claims 15-17 and 19-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nagano in view of Yamanaka (US 5,907,980). This basis for rejection is respectfully traversed for the same reason noted above.

Accordingly, it is believed that the rejections under 35 U.S.C. §102 and §103 have been overcome by the foregoing amendment and remarks, and it is submitted that the claims are in condition for allowance. Reconsideration of this application as amended is respectfully requested. Allowance of all claims is earnestly solicited.

Respectfully submitted,



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